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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,319	11/20/2003	Hyun-Seok Lee	678-272 DIV III CON	9769

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Paul J. Farrell, Esq.
DILWORTH & BARRESE, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553

EXAMINER

AFSHAR, KAMRAN

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,319

Applicant(s)

LEE ET AL.

Examiner

Kamran Afshar, 571-272-7796

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/20/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/26/2004</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Drawings***

1. Figures 1-8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 2001/0046878 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both basically claim the same subject matter which includes: 1) a method of determining Base Station transceiver system (BTS) to control Base station controller (BSC) in mobile communication system, 2) receiving reverse message, 3) indicating null frame, 4) transmission power control information, 5) detecting discontinuous transmission (DTX) mode, 6) forward DCCH message, 7) reverse DCCH message, 8) reverse message indicate erasure message, etc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim(s)1-14 of copending Application No. 2001/0046878 A1 contain(s) every element of claim(s)1-13 of the instant application and as such anticipate(s) claim(s)1-12 of the instant application.

4. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 2002/0012326 A1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both basically claim the same subject matter which includes: 1) a method of determining Base Station transceiver system (BTS) to control Base station controller (BSC) in mobile communication system, 2) receiving reverse message, 3) indicating null frame, 4) transmission power control information, 5) detecting discontinuous transmission (DTX) mode, 6) forward DCCH message, 7) reverse DCCH message, 8) reverse message indicate erasure message, etc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim(s)1-14 of copending Application No. 2002/0012326 A1 contain(s) every element of claim(s)1-12 of the instant application and as such anticipate(s) claim(s)1-12 of the instant application.

5. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,728,551B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both basically claim the same subject matter which includes: 1) a method of determining Base Station transceiver system (BTS) to control Base station controller (BSC) in mobile communication system, 2) receiving reverse message, 3) indicating null frame, 4) transmission power control information, 5)

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detecting discontinuous transmission (DTX) mode, 6) forward DCCH message, 7) reverse DCCH message, 8) reverse message indicate erasure message, etc.

Claim(s)1-15 of patent # 6,728,55 B2 contain(s) every element of claim(s)1-12 of the instant application and as such anticipate(s) claim(s)1-12 of the instant application.

6. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,731,948 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both basically claim the same subject matter which includes: 1) a method of determining Base Station transceiver system (BTS) to control Base station controller (BSC) in mobile communication system, 2) receiving reverse message, 3) indicating null frame, 4) transmission power control information, 5) detecting discontinuous transmission (DTX) mode, 6) forward DCCH message, 7) reverse DCCH message, 8) reverse message indicate erasure message, etc.

Claim(s) 1-5 of patent # 6,731,948 B1 contain(s) every element of claim(s)1-12 of the instant application and as such anticipate(s) claim(s)1-12 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30,

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2001).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Admitted Prior Art (APA).

With respect to claims 1, 5, 9, The APA discloses a method for determining, in a base station controller (BSC), information for controlling transmission power of a mobile station, the information depending on a signal received from a base station transceiver system (BTS), in a mobile communication system (See e.g. 14, 16a-16b, 12 of Figs. 1-2), the mobile communication system including the mobile station for transmitting and receiving data in a predetermined period, the base station transceiver system and the base station controller for controlling the base station transceiver system (See e.g. See e.g. Page 3, of Specification Lines 4-8), the method comprising the steps of: receiving, in the base station controller, a reverse / forward message (i.e. FCH reverse / forward power control messages) from the base station transceiver system; and determining / analyzing a type of a frame and / or data included in the received reverse / forward message (See e.g. Page 10 of Specification, Lines 1-7) and / or present power control information for controlling transmission power of the mobile station (See e.g. Page 6, Lines 4-14).

9. Claims 6-8, 10-11, 13-14 are rejected under 35 U.S.C. 102(e) as being anticipate by Chen (U.S. Patent 5,893,035).

With respect to claims 1, 5, 9, Chen discloses a method for determining, in a base station controller (BSC), information for controlling transmission power of a mobile station (See e.g. Co. 3, Lines

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6-10), information depending on a signal received from a base station transceiver system (BTS), in a mobile communication system, mobile communication system including mobile station for transmitting and receiving (See Abstract, 14, 16a-16b, 12 of Figs. 1-2), data in a predetermined period (See e.g. Co. 3, Lines 10-18), base station transceiver system and base station controller for controlling base station transceiver system (See e.g. 14, 16a, 16b, 12 of Fig. 2), the method comprising the steps of receiving, in the base station controller, a reverse / forward message (i.e. reverse / forward link frame) from the base station transceiver system (See e.g. Co. 3, Lines 21-29); and determining / analyzing (See e.g. Co. 6, Lines 34-38) type of a frame or data (i.e. determining / analyzing if EIB is value or "0" or "1") included in the received reverse / forward message (See Co. 7, Lines Co. 6, Lines 41-48, & Co. 9, Lines 40-54) and / or present power control information for controlling transmission power of the mobile station Co. 7, Lines 6-15, Co. 11, Line 50 – Co. 12, Line 3, Table 1).

Allowable Subject Matter

10. Claims 10-12 are allowed.

The following is an examiner's statement of reasons for allowance: 10-12.

With respect to claim 10, Chen (U.S. Patent 5,893,035) is the closest prior art to the application invention, which are discussed above in the rejected claims 1, 5, 9. However, the prior art of record fails to disclose or render obvious that detecting the discontinuous transmission (DTX) mode if there is no reverse traffic; setting a reverse traffic channel quality field to zero; and transmitting the information of the reverse link quality field to the base station controller.

With respect to claim 11, the prior art of record fails to disclose or render obvious that setting a previous power control information at the time point where the DTX mode is detected, to a present power control information at the time point where the DTX mode is detected, to a present power control information if a DCCH forward message last received from the base station controller is not a null frame; and transmitting the present power control information to base station controller.

With respect to claim 11, the prior art of record fails to disclose or render obvious that determining whether the information of the reverse traffic channel quality field in the reverse message is zero; and

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setting previous power control information to present power control information if the information of the reverse traffic channel quality field is zero.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

11. Claims 2-4, 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 2, the prior art of record fails to disclose or render obvious that the reverse message is a null frame and the power control information is for controlling transmission power of the mobile station, and the previous power control information was used prior to receipt of the null frame indicating that there is no data to transmit.

Regarding claim 3, the prior art of record fails to disclose or render obvious that setting present power control information to increase transmission power of the mobile station, if the type of frame of the reverse message is an erasure frame.

Regarding claim 4, the prior art of record fails to disclose or render obvious that setting power control information initially defined during resource assignment to present power control information, if the frame type of the reverse message is an idle frame.

Regarding claim 6, the prior art of record fails to disclose or render obvious that setting previous power control information used for power control of the mobile station prior to receipt of a null frame as present power control information for controlling transmission power of the mobile station, if the frame type of the forward message is a null frame indicating that there is no data to transmit.

Regarding claim 7, the prior art of record fails to disclose or render obvious that setting power control information included in the forward message as the present power control information, if the frame type of the forward message is an idle frame.

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Regarding claim 8, the prior art of record fails to disclose or render obvious that setting present power control information to increase transmission power of the mobile station, if the type of frame of the forward message is an erasure frame.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Lin (U.S. Patent 6,249,894 B1), which discloses Method For Determining A Need To Retransmit A Message In A Communication System.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (571) 272-7796. The examiner can be reached on Monday-Friday.

If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, **Emmanuel Moise** can be reached @ (571) 272-3865. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kamran Afshar


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER